REMARKS

Applicant has carefully reviewed the Office Action mailed January 10, 2005, prior to preparing this response. Currently claims 1, 2, 5 and 8-16 are pending in the application, wherein claims 1, 2, 5 and 8-16 have been rejected. New claims 17-22 have been added with this amendment. Applicant asserts the new claims are fully supported by the specification, thus no new matter has been added in the claims. Favorable consideration of the above amendments and following remarks is respectfully requested.

Claims 1, 2, 5, 8, 9, 11, 15 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rosenthal et al. (U.S. Patent No. 6,285,903) in view of Lurie et al. (U.S. Patent No. 5,722,963). Applicant respectfully traverses this rejection. In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention. See M.P.E.P. §2143.01. Applicant asserts there is no motivation to combine the references in order to reach the claimed invention. There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. M.P.E.P. §2143.01. None of these sources of motivation is present regarding the suggested combination.

Rosenthal et al. teach an intracorporeal device for use to access the left ventricle of a heart which includes a radiopaque marker to allow an operator to fluoroscopically detect the orientation of the distal end of the device. See column 7, lines 35-38 and column 2, lines 23-44. Conversely, Lurie et al. teach a coronary sinus catheter for insertion in the ostium of the coronary sinus in the right atrium including electrodes located toward the distal end of the catheter to take electrophysiology readings within the coronary sinus. See Abstract and column 5, line 57 through column 6, line 50. Therefore, Rosenthal et al. and Lurie et al. each attempt to solve very distinct problems in the vascular system.

Additionally, each reference provides a distinct catheter configuration suitable for its intended purpose. For instance, Rosenthal et al. disclose the preferred embodiment of an intracorporeal device having specified dimensions and parameters at column 3, lines 1-47. The preferred catheter system of Rosenthal et al. shown in Figure 1 is intended to access the left ventricle of a heart. See column 7, lines 35-38. The catheter taught in Lurie et al. has a unique curvature specifically configured to access the coronary sinus in the right atrium. See column 4,

lines 34-35 and column 6, lines 44-48. The unique curvature includes two curves, wherein the second curve is an extension of the first curve and curving in the same direction. See column 5, lines 28-46. Each reference teaches the need for a unique catheter configuration necessary in order to reach a specific location within a heart. Therefore, the teachings of the prior art would not suggest modification of the preferred embodiments since a modification would render the device inoperable for its intended purpose (i.e., navigating to a particular location in the heart to perform a specific medical procedure), Thus, the teachings of the references demonstrate that there is no suggestion or motivation to make the proposed modification. See M.P.E.P. 2143.01.

Finally, one of ordinary skill in the art, understanding the complexity of the heart, would not be inclined to modify the teachings of Rosenthal et al. in view of Lurie et al. One would not look to a catheter specifically configured to access the coronary sinus in the right atrium in an attempt to modify a catheter configured to access the left ventricle. Each of the catheters is configured to navigate to a particular location within the heart.

For at least the reasons stated above, to would be unobvious to combine the teachings of Rosenthal et al. with those of Lurie et al. Such a proposed modification would render the modified device unsatisfactory for its intended purpose, and thus provide no motivation for the combination. Therefore, a *prima facie* case of obviousness has not been established with the stated combination. For at least the reasons stated above, claims 1, 2, 5, 8, 9, 11, 15 and 16 are believed patentable over Rosenthal et al. and Lurie et al., and withdrawal of the rejection is respectfully requested.

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Rosenthal et al. (U.S. Patent No. 6,285,903) in view of Lurie et al. (U.S. Patent No. 5,722,963), and further in view of Hassett (U.S. Patent No. 6,156,018). The Examiner asserts the combination of Rosenthal et al. and Lurie et al. teach all the limitations of claim 10 except that the shaft is tapered toward its distal end, and Hassett teaches such a taper. Applicant respectfully traverses this rejection.

As stated above, there is no motivation to combine the teachings of Rosenthal et al. with those of Lurie et al. Furthermore, Hassett fails to provide motivation to reach the combination. Therefore, a *prima facie* case of obviousness has not been established with the combination for at

least the reasons stated above. Claim 10 is believed patentable over the combination and withdrawal of the rejection is respectfully requested.

Claims 12, 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rosenthal et al. (U.S. Patent No. 6,285,903) in view of Lurie et al. (U.S. Patent No. 5,722,963), and further in view of Abrams et al. (U.S. Patent No. 5,637,089). The Examiner asserts the combination of Rosenthal et al. and Lurie et al. teach all the limitations of claims 12, 13 and 14 except for a helically wound spring with a rounded terminal element provided at the distal end as stated in claim 12 and the shaft comprising a superelastic material as stated in claims 13 and 14. The Examiner asserts Abrams et al. teach these limitations. Applicant respectfully traverses this rejection.

As stated above, there is no motivation to combine the teachings of Rosenthal et al. with those of Lurie et al. Furthermore, Abrams et al. fail to provide motivation to reach the combination. Abrams et al. teach a guiding member including a core member comprising a superelastic material. The proposed modification of combining the core member of Abrams et al. with the catheter of either Rosenthal et al. or Lurie et al. would render the prior art invention unsatisfactory for its intended purpose. The catheter of Rosenthal et al. utilizes a lumen in order to perform a desired therapy such as myocardial revascularization, tissue ablation, or delivery of an angiogenic agent. See column 1, lines 11-16. The catheter of Lurie et al. may provide access for the infusion of fluids or withdrawal of blood samples. See column 6, lines 18-21. Modifying the prior art with the superelastic core member of Abrams et al. would eliminate the lumen from the catheter, thus making the catheter inoperable for its intended purpose. As a result of the inoperability of the modified invention, there is no suggestion or motivation to make the proposed modification. See M.P.E.P. §2143.01. Therefore, a *prima facie* case of obviousness has not been established with the combination for at least the reasons stated above. Claims 12, 13 and 14 are believed patentable over the combination, and withdrawal of the rejection is respectfully requested.

Newly added claims 17-22 include elements and limitations not found in the prior art. Therefore, they are also believed to be in condition for allowance. Favorable consideration of the newly added claims is respectfully requested.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Michael Schwager

By his Attorney,

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